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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/804,900	02/24/97	MECHALEY	06318/005001

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EXAMINER
HUGHET, W

ART UNIT	PAPER NUMBER
2761	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/804,900

Applicant(s)

Robert Mechaley, Richard A. Miner

Examiner

William N. Hugnet

Group Art Unit

2761

☒ Responsive to communication(s) filed on Feb 24, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Part III DETAILED ACTION**

#### *Notice*

1. Effective November 16, 1997, the Examiner handling this application was assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the Official Gazette notice dated November 11, 1997. For any written or facsimile communication submitted ON OR AFTER November 16, 1997, this Examiner, who was assigned to Art Unit 2411, will be assigned to Art Unit 2761. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

#### *Drawings*

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
3. The disclosure is objected to because of irregularities as noted on PTO 948. Appropriate correction is required.

#### *Specification*

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The Examiner respectfully suggests the following title: "Method and Apparatus for Offering Additional Product Functions to a User".
5. The application is objected to as not being in compliance with 37 C.F.R. 1.77 regarding the required elements of the application. In particular, this application is lacking a section entitled, "Cross-References to Related Applications" which should reference copending application No. 08/861,792, filed May 22, 1997. In addition, the Specification should be updated at page 3 to reflect that application No. 08/316,635 was issued as U.S. Patent No. 5,652,789 on July 29, 1997. Also, the Appendix A referenced at line 5, page 4 of the Specification is not in the

application. In view of the fact that the missing Appendix is referenced as constituting a previously filed patent application, now issued, the Examiner respectfully advises Applicants that an application may contain only one appendix and it must contain only source code. Therefore, Applicants may wish to remove this reference to Appendix A from the Specification.

*Claim Rejections - 35 USC § 101*

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

7. Claims 1 - 11 and 18 - 20 are rejected under 35 U.S.C. § 101 because the claimed invention is non-statutory as not being within the technological art. In particular, the claimed invention is directed at a method of gathering usage data and informing a user when his/her usage exceeds a predetermined threshold, which in and of itself, fails to recite statutory subject matter. Loew's Drive-In Theatres, Inc. v. Park-On Theatres, Inc., 81 U.S.P.Q. 149, 153 (1949) (noting that an idea, no matter how new and useful it may be, is not of itself patentable).

Although the application clearly discloses at page 4 of the Specification that the invention is to be implemented on a computer, the above-referenced claims recite a method for gathering data, determining when a pattern in the data has been identified or a threshold reached, and informing the user of a product upgrade indicated by said pattern or threshold. The Examiner asserts that such a method could easily be implemented manually without aid of any processing device. No apparatus is claimed, and, in particular, no computer or processing means is claimed that would raise the concepts disclosed from the level of data analysis to that of a patentable invention.

It is fundamental patent law that an idea, without means to implement it, is not eligible for patent protection. Loew's Drive-In Theatres, Inc., 81 U.S.P.Q. at 153. Similarly, simple manipulation of the idea, such as gathering data and determining when a pattern or threshold has been recognized, is insufficient to qualify as statutory subject matter. In re Warmerdam, 31 U.S.P.Q.2d at 1759 (noting that mere manipulation of data or ideas is not statutory subject matter). A manipulation of usage data, without the apparatus to effect the analysis and offering to the user, is not of itself patentable. State Street Bank and Trust Co. v. Signature Financial Group, Inc., 38 U.S.P.Q.2d 1531, 1535 (1996).

The Examiner respectfully suggests adding language similar to "a computer-implemented method for . . ." to independent Claims 1 and 18 to clearly denote the implementation of the invention on a computer.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9. Claims 1 - 27 are rejected under 35 USC § 103 as being unpatentable over Coffey et al. (U.S. Patent No. 5,675,510) in view of Jason Meyers, "CDMA Gets its Day in the Sun", Telephony, v 230, n 21, page 8, May 20, 1996 (hereinafter "CDMA").

(A) As to Claim 1, Coffey discloses a computer-based system for collecting data regarding usage of software products on a plurality of computers and corresponding users across a communications network (Coffey at abstract; Col 1, lines 36 - 50 and 57 - 64; Col 2, lines 1 - 11; Col 3, lines 45 - 47). The usage data is analyzed to produce information useful to marketing (Col 2, lines 62 - 67; Col 3, lines 25 - 28). Information requests are interactively communicated to the users (Col 3, lines 19 - 21). Although Coffey teaches that the system is useful to marketing, it does not expressly disclose offering upgraded features to users based on an identified pattern from the analyzed usage data. However, CDMA is an article disclosing the release of upgraded cellular services to the customers of AirTouch Communications, Inc. in the Los Angeles, California market. In particular, CDMA discloses offering greater cellular communications functionality based on past usage patterns (CDMA at page 1, lines 14 - 16 and 36 - 37). It would have been obvious to one of ordinary skill in the art of resource management to modify Coffey with the communications analysis and offering method of CDMA. Coffey discloses that there exists an intense need to measure use of computer related resources and disseminate related information (Coffey at Col 1, lines 24 - 28). Coffey also teaches that their invention helps satisfy this need by monitoring and logging certain external communications (Coffey at Col 2, lines 35 - 36). The motivation to modify the teachings of Coffey with those of CDMA would be to provide the detail of how the logging of communications information may be analyzed and the results disseminated in the form of offering greater communications functionality to qualified users.

The Coffey/CDMA combination, therefore, is a computer-based system for collecting data regarding the usage of a plurality of software (Coffey at Col 2, lines 62 -

65) and communications products (Coffey at Col 2, lines 35 - 36; CDMA at page 1, lines 14 - 16 and 36 - 37), analyzing said data (Coffey at Col 2, lines 65 - 67; CDMA at page 1, lines 36 - 37), and offering product upgrades to qualified users (CDMA at page 1, lines 36 - 37).

(B) As to Claim 2, Coffey discloses collecting interval of use data (Col 3, lines 61 - 65).

(C) As to Claims 3 - 5, Coffey discloses collecting statistical, demographic, and geographic data (Col 3, lines 54 - 61; Col 4, lines 33 - 38).

(D) As to Claim 6, CDMA discloses determining whether a threshold has been exceeded as indicated by usage data such that the user is to be offered communications upgrades.

(E) As to Claim 7, although the Coffey/CDMA combination discloses analysis of product usage data to determine whether a data pattern can be identified, neither Coffey nor CDMA expressly teach application of a fuzzy algorithm to said analysis. However, the Examiner asserts that use of a fuzzy algorithm is merely a design choice from among a plurality of known analysis methods.

(F) As to Claim 8, Coffey discloses interactively communicating with users (Col 3, lines 19 - 21).

(G) As to Claim 9, the Examiner asserts that interactive voice communication is well known in the art and would have therefore been an obvious method of communication with the user.

(H) As to Claim 10, the Examiner asserts that computer displays and keyboards are well known means of communication between computer systems and users.

(I) As to Claim 11, Coffey discloses collecting data regarding user decisions to invoke various software products (Col 1, lines 57 - 62). The remaining limitations of Claim 11 are found in Claim 1, and the remainder of this claim is rejected for the same reasons.

(J) As to Claim 12, the Examiner asserts that the personal assistant system disclosed in the Specification at page 5, lines 18 - 20 cites to Application No. 08/316,635 (now U.S. Patent No. 5,652,789), which is disclosed therein to be a software product for facilitating communications (Miner at Col 1, lines 5 - 7; Col 10, lines 44 - 50). As such, the Examiner asserts that the recited personal assistant system falls within the class of software products of Coffey. Therefore, the limitations of Claim 12 are found in Claims 1 and 9, and this claim is rejected for the same reasons.

(K) The limitations of Claim 13 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(L) The limitations of Claim 14 are found in Claim 11, and this claim is rejected for the same reasons.

(M) The limitations of Claim 15 are found in Claims 8 and 9, and this claim is rejected for the same reasons.

(N) The limitations of Claim 16 are found in Claims 1 and 10, and this claim is rejected for the same reasons.

(O) As to Claim 17, CDMA discloses offering greater functionality dependent on usage patterns. The Examiner asserts that by being eligible for greater functionality, the users by necessity were started at a lower functionality level.

(P) The limitations of Claim 18 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(Q) The limitations of Claims 19 and 20 are found in Claims 2 and 3, respectively, and these claims are rejected for the same reasons.

(R) The limitations of Claim 21 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(S) The limitations of Claims 22 - 24 are found in Claims 1 - 3, respectively, and these claims are rejected for the same reasons.



(T) The limitations of Claim 25 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(U) The limitations of Claims 26 and 27 are found in Claims 2 and 3, respectively, and these claims are rejected for the same reasons.

### *Conclusion*

10. The following prior art is made of record and is not relied upon, but is considered pertinent to Applicant's disclosure:

- Miner et al. (U.S. Patent No. 5,652,789)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Hughet, whose telephone number is (703) 305-9770. The examiner can be reached on Monday through Friday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

William N. Hughet  
May 05, 1998  
(08804900.AC1) *WNH*

*Gail Hayes*  
GAIL O. HAYES  
SUPERVISORY PATENT EXAMINER  
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